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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/617,322   | 07/09/2003  | Thomas Edward Dinan  | SA9-99-140US2       | 2820             |
| 32112  | 7590        | 03/17/2005           | EXAMINER            |                  |
| INTELLECTUAL PROPERTY LAW OFFICE<br>1901 S. BASCOM AVENUE, SUITE 660<br>CAMPBELL, CA 95008 |             |                      |                     | CHEN, TIANJIE    |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2652                |                  |

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                         |  |
|------------------------------|------------------------|-------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> (5) |  |
|                              | 10/617,322             | DINAN ET AL.            |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>         |  |
|                              | Tianjie Chen           | 2652                    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 November 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-18 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 19-30 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20030709.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

***Non-Final Rejection***

***Election/Restrictions***

1. Applicant's election without traverse of Group II claims 19-30 in the reply filed on 11/04/2004 is acknowledged.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 20 and 26 recite the limitation "said metallic component" in line 1; and claims 23 and 29 recite the limitation "said yoke" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 19-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen et al (US 5,995,342).

Claims 19 and 25, Cohen et al shows a thin film device in Figs. 1A and 2 including: at least one thin film layer 16; at least one component 32A; the component being formed with an overplated head (the whole portion above 16) that includes overhang portions 28; hard baked photoresist 40 (Column 18, lines 40-49) being

disposed beneath the overhang portions to fill an area beneath the overhang portions 28.

Claim 25, Cohen further shows the thin film device is inherently used to an hard disk drive (Column 1, lines 12-47), including: at least one hard disk being adapted for rotary motion upon a drive device; at least one slider device having a slider body portion being adapted to fly over the hard disk; a magnetic head being formed on slider body for writing data on the hard disk.

Claims 20 and 26, Cohen et al further shows that the component 32A is formed into an opening formed in a photoresist layer (Column 13, lines 3-6).

Claims 21 and 27, Cohen et al further shows that the device is a thin film magnetic head.

Claims 24 and 30, Cohen et al further shows in Fig. 3(a) that the component 32A is an electrical interconnecting stud.

Claims 22/19 and 28/25 Cohen et al shows a thin film device in Figs. 1A and 2 including: at least one thin film layer 16; at least one component 20; the component being formed with an overplated head (the whole portion above 16) that includes overhang portions 28; hard baked photoresist 40 (Column 18, lines 40-49) being disposed beneath the overhang portions to fill an area beneath the overhang portions 28; the component 20 is a yoke portion of a magnetic pole.

Claims 23 and 29, Cohen further shows in Fig. 1A that the yoke 20+28 is formed with straight sided pole tip portions 22 and 30 and overplated yoke portions 28 and 26.

***Examiner's Note***

4. A "product by process" claim is directed to the product per se, no matter how actually made, see *In re Hirao*, 190 USPQ 15 at 17 (footnote 3 CCPC, 5/27/76); *In re Brown*, 173 USPQ 685 (CCPA 5/18/72); *In re Luck*, 177 USPQ 523 (CCPA, 4/26/73); *In re Fessmann*, 180 USPQ 324 (CCPA, 1/10/74); *In re Thorpe*, 227 USPQ 964 (CAFC, 11/21/85). The patentability of the final product in a "product by process" claim must be determined by the product itself and not the actual process and an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. In this Application, the elected claims 19-30 all claim a product and also recite some process related limitations, such as "electrochemically plated," "had baked," and "photolithographic process techniques." These limitations do not gain weight in determining patentability in "product by process" claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tianjie Chen whose telephone number is 571-272-7570. The examiner can normally be reached on Flexible.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on 571-272-7579. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TIANJIE CHEN  
PRIMARY EXAMINER